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REMARKS

No claims have been allowed.

I. The Rejections

(a) Claims 1-2, 4-8, 11-15 and 19 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Desai et al (US 6034746) in view of Chen et al. (US 5917830).

(b) Claims 3, 9-10, 16-18 and 20 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Desai et al (US 6034746) in view of Chen et al. (US 5917830) and further in view of Sakamoto et al. (US 6026164).

2. The Response

(a) The Rejection of claims 1-2, 4-8, 11-15 and 19 Based on Desai in view of Chen

As indicated by the Examiner, Desai is concerned with combining encoded data representing a first (higher resolution or main) video program with encoded data representing a second (lower resolution) video program such as a commercial. However, Desai goes about doing this task in a significantly different way than Applicant's claimed invention. In Desai, (see col. 5, lines 1-4), it is stated:

"To allow for insertion of commercial data, the distributor of a movie provides control information, including a commercial insert file, and one or more data files, along with the movie".

Furthermore, Desai (col. 5, line 23) states:

"When a client (e.g. client 10 in FIG. 1) requests an audio/video asset, a play list is typically constructed by a controller (e.g., controller 16 in FIG. 1). The play list is used to control which data is sent, and in what order the data is sent, from data pump 18 to client 10. The commercial insert file and the data files allow a play list to be constructed such that the movie is played with commercials".

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Thus, the "distributor" adds certain "files" to the program which is provided so that the movie can accommodate commercials at the "client".

In the Office Action, the Examiner acknowledges, referring to specific attributes recited in the rejected claims, that "Desai fails to disclose simultaneously receiving and seamlessly incorporating the first and second video streams" into packetized data as required by each of rejected claims 1 – 8 and 19.

The Examiner seeks to bridge this gap by relying upon Chen et al. Chen describes "a method and apparatus ---- for splicing a secondary packetized data stream, such as a commercial, with a primary packetized data stream, such as a network television program ----- (which method) is particularly suitable for use at a cable system headend." (col. 2, lines 11 – 17).

The Examiner concluded that "it would have been obvious ---- to take the apparatus disclosed by Desai and add the processing taught by Chen in order to obtain an apparatus that operates more efficiently by reducing the time needed to insert commercials into a stream" (Final Rejection, bottom of page 4).

However, the Examiner has not demonstrated that there is any motivation for a person of ordinary skill to combine anything from the Desai and Chen references. In response to Applicant's position that no motivation has been shown for combining Desai with Chen, the Examiner states (page 2):

"Chen discloses in column 1, lines 40 – 50 that a number of time consuming steps are required for inserting commercials into streams. Hence, Chen discloses an apparatus trying to reduce the number of steps needed to perform these operations. Since both references are within the same field of endeavor and contain similar subject matter, the combination is deemed proper". But no "motivation" for combining these references is shown by the foregoing statement or by what Chen says. Reducing the time needed to insert commercials into a stream is not mentioned to be a concern of Desai.

Furthermore, considering the specifics of Chen, column 1, lines 40 – 50, (see below), that description can be seen to be completely irrelevant to anything Desai discloses and to provide no motivation for combining Chen with Desai. The cited text in Chen (and a few lines preceding that text) reads:

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"In particular, commercial messages from local businesses may be inserted into the main programs (at the headend). However, in order to accomplish this, conventionally the received digital data stream must be completely demodulated, demultiplexed, decrypted, decompressed and decoded to recover the signal in the analog domain. Then the desired commercial message is provided in the analog domain and inserted into the signal to provide a new analog combined signal. Finally the analog combined signal is digitized, encoded, compressed, encrypted, multiplexed and modulated for transmission to a customer's home".

None of the foregoing quoted text has any relevance to Desai's system. Desai does not use any of those steps or processes relating to combining commercial messages and main programs in the analog domain. That is the system which would result in the time problems which Chen discusses. Since Desai is not faced with any of those problems described by Chen, there is no motivation or suggestion found in either Chen or Desai to combine those two references.

Furthermore, the Examiner has identified neither "the processing taught by Chen" that would be suitable to add to Desai nor the "apparatus disclosed by Desai" that would be useful with Chen's "processing" in order to arrive at the presently claimed inventive combination(s).

It is submitted that the apparatus disclosed by Desai, since it is not concerned at all with simultaneously receiving and seamlessly incorporating the first and second video streams into packetized data as required by each of rejected claims 1 – 8 and 19, cannot be expected to be useful at all in connection with any processing disclosed by Chen.

It is therefore submitted that the attempted combination of Chen with Desai fails to meet the requirements for supporting a rejection under § 103.

It should also be noted that dependent claims 11 – 15, which are dependent on claim 9 (see below), also include "simultaneously" and "seamlessly". Therefore, claims 9 – 18, 19 and 20 are submitted to distinguish over Desai as well. This deficiency is not made up by Chen.

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Basis for Rejections Under 35 U.S.C. § 103(a)

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings of a plurality of references. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's own disclosure. In re Vaeck, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

The examiner bears the burden of establishing a prima facie case of obviousness and "can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988, emphasis added). To support a conclusion that a claimed combination is obvious, either: (a) the references must expressly or impliedly suggest the claimed combination to one of ordinary skill in the art, or (b) the examiner must present a convincing line of reasoning as to why a person of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. Ex parte Clapp, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985).

The § 103(a) Rejections of Claims 1-2, 4-8, 11-15 and 19 Are Traversed

The action does not make out a prima facie case of obviousness with respect to any of the rejected claims.

There is clearly no objective teaching in either cited reference that would lead an individual of ordinary skill to somehow combine Desai and Chen to arrive at Applicant's claimed combinations. Under the law applied in obviousness rejections, the Examiner's rejection should be withdrawn (In re Fine, supra).

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It is respectfully submitted that neither of the cited references satisfies the requirement of teaching or suggesting modifying either reference in any manner to arrive at the claimed combinations of apparatus or method elements. Furthermore, it is respectfully submitted that a prima facie case of obviousness is not made out on the basis of these references since there is nothing which would suggest or motivate anyone to modify the references in a way which would be consistent with the present claims. Finally, there would be no reasonable expectation of success for any purpose by modifying these references as the Examiner suggests.

It is respectfully submitted that the § 103(a) rejection of these claims should be withdrawn and those claims, as amended should be allowed.

(b)The rejection of claims 3, 9-10, 16-18 and 20 based on Desai in view of Chen and further in view of Sakamoto

The third reference, Sakamoto et al., is relied on against claims 3, 9-10, 16-18 and 20 on the basis that Sakamoto discloses "upconverting the decoded second resolution data" (Rejection, page 6).

Only dependent claims 3 and 10 include "upconverting". It is submitted, therefore, that Sakamoto is not even relevant to claims 9, 10, 16-18 and 20.

In addition, Sakamoto does not disclose any of the features of the present claims pointed out above in distinguishing this invention over Desai and/or Chen. It should be noted that Sakamoto describes significantly different arrangements for transmitting and decoding a plurality of entire encrypted datastreams for Pay TV, which is not relevant to the presently claimed invention.

In the citation of Sakamoto, the Examiner notes that reference "teaches that it is difficult to effect scrambling without changing the code length (Sakamoto, col. 2, lines 1-3)". This statement is totally unrelated to the presently claimed invention and relates only to the fact that Sakamoto is concerned with "a communication processing system --- which performs a scrambling process on digital television signals and broadcast (sic) them, and more particularly to pay broadcasting techniques" (Sakamoto, col. 1, lines 16-19).

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Sakamoto describes his system beginning at col. 7, line 65, as one in which "low quality layer data S2 and high quality layer data S3 are encrypted and then transmitted, the images cannot be viewed unless not only the layer decoding unit 134 but also the decrypting units 133a and 133b are provided on the reception apparatus side". As part of his pay TV encryption scheme, Sakamoto uses an "HDTV signal which undergoes a 1/2 down sampling process at a down sampling circuit 221 and is sent to an SDTV (Standard Definition TV) compression layer encoder 23" (col. 8, line 50).

Thereafter, the video signal subjected to the compression process at the SDTV encoder 23 is supplied to the HDTV encoder 22 (see col. 9, lines 5-8). The SDTV compressed signal is subjected to a twice up sampling process at an up sampling circuit 222.

This sequence of, first, down sampling an HDTV signal to produce a low quality (actually corrupted and almost unviewable) signal that may be previewed by a pay-TV non-subscriber, and then up sampling the low quality signal to use it in processing the low quality signal for "previewing", has no relationship whatsoever to the presently claimed invention (or to either of the other two cited references). The Examiner's conclusion that Sakamoto "taught" "upconverting the decoded second resolution data" to alleviate a problem concerned with "scrambling (the data) without changing the code length" is without meaning in connection with the presently claimed invention which has nothing to do with scrambling. It is respectfully requested that the rejection of claims based on the combination of Desai in view of Chen and further in view of Sakamoto be reconsidered and withdrawn based on the foregoing distinctions between what is claimed and what the references disclose plus the fact that a prima facie case of obviousness cannot be made out based on these references.

That is, as noted above, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine the teachings of a plurality of references. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be

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found in the prior art, and not based on the applicant's own disclosure. In re
Vaeck, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

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The necessary criteria have not been met.

The § 103(a) Rejections of Claims 3, 9-10, 16-18 and 20 Are Traversed

The action does not make out a prima facie case of obviousness
with respect to any of the rejected claims.

There is clearly no objective teaching in either cited reference that
would lead an individual of ordinary skill to somehow combine Desai and Chen
with Sakamoto to arrive at Applicant's claimed combinations. Under the law
applied in obviousness rejections, the Examiner's rejection should be withdrawn
(In re Fine, supra).

3. Conclusion

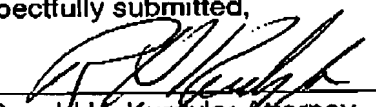
Independent claims 1, 9 and 19 each include distinguishing
features as pointed out above which are not found in the cited references or any
combination of those references.

In view of the foregoing Remarks, reconsideration and withdrawal
of all of the rejections and allowance of all pending claims 1 – 20 are respectfully
requested.

Entry of this amendment under 37 CFR 116 (b) is respectfully
requested on the grounds it places this application in condition for allowance
and/or in better condition for appeal.

Respectfully submitted,

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